

## REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Initially, the abstract of the disclosure has been amended to contain only a single paragraph and to delete legal phraseology, thus rendering moot the objection to the abstract, as set forth by the Examiner in items 5 and 6 on pages 2 and 3 of the Office Action.

The specification has been amended on page 4, line 6 and page 20, line 11 to correct minor typographical errors. Applicants have further amended the specification to place each trademark in all capital letters, in response to the Examiner's comments in item 7 on page 3 of the Office Action. MPEP 608.01(v) states that if the product to which the trademark refers is set forth in such language that its identity is clear, then the use of trademarks is permitted if they are distinguished from common descriptive nouns by capitalization. Further, the MPEP states that trademarks should be identified by capitalizing each letter of the mark or otherwise indicating the description of the mark. Therefore, Applicants' use of trademarks in the specification is proper.

Claim 1 has been amended to correctly recite a Markush group, thus rendering moot the rejection to this claim under the second paragraph of 35 U.S.C. § 112. Claim 1 has been further amended to incorporate the limitations of Claims 14 and 15, as a result of which Claims 14 and 15 have been canceled. Claim 6 has been amended to delete "in particular, C<sub>2</sub>-C<sub>3</sub>" and "preferably 1-5", thus rendering moot the rejection to this claim under the second paragraph of 35 U.S.C. § 112. Claim 18 has been amended to correct a typographical error.

The rejection of claims 1-19 as being indefinite under 35 U.S.C. § 112, second paragraph, as set forth in item 10 on pages 3 and 4 of the Office Action is respectfully traversed. The standard for determining whether a claim is definite under the second paragraph of 35 U.S.C. § 112, is that one of ordinary skill in the art would recognize the subject matter on which the claim reads, i.e. the subject matter encompassed by the claim. That is, the claims should be of sufficient clarity so that the art-skilled would be able to determine whether any given subject matter is either within or not within the scope of the claim. We have discovered three U.S. patents, copies of which are enclosed, which use the term "rigid" in the claims. [Each of the

patents was issued by Timothy Meeks, the Examiner's supervisor.] Therefore, due to the presence of the term "rigid" in these other patents, it is clear that one of ordinary skill in the art would recognize the subject matter encompassed by claims which include the term "rigid".

Additionally, MPEP 2173.02 states that definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. The Examiner states that the specification provides examples of suitable rigid resin parts, but provides no explicit definition of the term rigid. However, the standard for determining definiteness does not require that the specification provide an explicit definition of a term. MPEP 2173.02 states that a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. In *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.* the court held that a disputed claim term which was not defined or used in the specification was discernible and not indefinite because "the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence." See *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 249 F.3d 1367 (Fed. Cir. 2004).

For these reasons, the rejection of claims 1-19 as being indefinite due to the term "rigid" is unfounded and should be withdrawn.

The patentability of the present invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of Claims 1 and 3-19 under 35 U.S.C. § 103(a) as being unpatentable over Rink et al. is respectfully traversed.

The Examiner takes the position that Rink et al. teach a process for coating plastic automotive parties with a multilayer paint film coating, comprising applying a color base paint coating to the surface of a part, applying a clear top paint coat atop the base coat and baking the two paint films.

However, as stated above, claim 1 has been amended to recite that the clear paint further comprises 1-20% by weight of hydroxyl-containing oligomer (C) which is a reaction product of a carboxyl-containing compound with an epoxy-containing compound, based on the combined solid content of the acrylic resin (A) and the curing agent (B).

Thus, Claim 1 recites a paint film forming method comprising applying color base paint onto rigid resin parts and then clear paint and curing the two paint films, wherein the clear paint comprises the following three components:

- (A) a specific hydroxyl-containing acrylic resin,
- (B) a curing agent, and
- (C) a hydroxyl-containing oligomer.

The clear paint as recited in claim 1 excels in low temperature-curability and, according to the present invention, can form paint film excelling in finish performance, film performance and paint stability on rigid resin parts, upon baking at a low temperature for a short time. Further, the inclusion of hydroxyl-containing oligomer (C) further improves clear paint film in leveling property and adherability.

Rink et al. disclose a coating composition usable as a transparent topcoat over a base coat, which may generically encompass components (A) and (B) as defined in the present invention. However, Rink et al. do not teach or suggest a clear paint comprising component (C) as specified in amended claim 1, i.e., hydroxyl-containing oligomer which is a reaction product of a carboxyl-containing compound with an epoxy-containing compound.

Rink et al. mention at column 8, line 51, that the coating composition may additionally contain, if desired, one or more other hydroxyl group-containing resins. Nothing is taught or suggested therein, however, on a clear paint comprising hydroxyl-containing oligomer (C) as defined in amended claim 1.

Citing column 6, lines 27-29 of Rink et al., the Examiner says with respect to claims 14 and 15 of the present application, "Rink teaches that the coating composition may further contain up to 20% by weight of a hydroxyl-group containing oligomer that is the reaction product of (meth)acrylic acid (i.e., a carboxyl group-containing compound) with a glycidyl ester of a

carboxylic acid (i.e., an epoxy-containing compound)". However, the Examiner misunderstands this passage of the reference. The passage of Rink et al. relied on by the Examiner relates to monomer component (b) which is to be copolymerized with monomers (a) and (c)-(f) for the production of hydroxyl group-containing polyacrylate resin. The passage does not refer to the third binder component which is additionally added to the coating composition.

As stated above, Rink et al. do not teach or suggest a clear paint comprising hydroxyl-containing oligomer (C) in addition to the hydroxyl group-containing polyacrylate resin and the curing agent, as defined in amended claim 1.

As is evident from Comparative Examples 8-11 in the enclosed Rule 1.132 Declaration by Mr. Masami Suwama, one of co-inventors of this application, a clear paint which contains only hydroxyl group-containing acrylate resin (A) and curing agent (B), and does not contain hydroxyl-containing oligomer (C) as specified in amended claim 1, does not result in a coating film which is excellent in adherability and finishing property.

On the contrary, Examples 1-3, according to amended claim 1, have excellent adherability and finishing property, as shown in Table 3A of the enclosed Rule 1.132 Declaration.

Rink et al. disclose that the coating composition may additionally contain further hydroxyl group-containing acrylate resins (see column 8, lines 51-58). However, as is clearly seen in the Comparative Example 11 of the enclosed Declaration, the hydroxyl group-containing acrylate resin which Rink et al. recite as suitable in column 9, lines 4-41, when used in place of hydroxyl-containing oligomer (C) of the present invention, fails to result in a clear paint which forms a coating film excellent in adherability and finishing property.

Rink et al. do not teach or suggest a clear paint comprising hydroxyl-containing oligomer (C), as recited in amended claim 1. Nor do Rink et al. teach or suggest the superior effects which would be attained by the use of specific hydroxyl-containing oligomer (C) in addition to hydroxyl-containing acrylic resin (A) and curing agent (B).

Claims 3-13 and 16-19 (claims 14 and 15 have been cancelled) are directly or indirectly dependent on claim 1. Therefore, the subject matter of claims 3-13 and 16-19 is patentable over Rink et al. for the same reasons the subject matter of claim 1 is patentable over Rink et al.

Therefore, the subject matter of claims 1 and 3-19 is clearly patentable over Rink et al.

The rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Rink et al., as applied to claim 1 above, and further in view of Asahina et al. and Croft is respectfully traversed.

The Examiner takes the position that one of ordinary skill in the art would have looked to the prior art to find a suitable base coat composition. The Examiner relies on Asahina et al. as teaching a color base coating composition, and Croft as teaching the blocking of polyisocyanates with acetoacetic ester and diethyl malonate.

However, as discussed above, Rink et al. do not teach the clear paint composition recited in amended claim 1. Neither Asahina et al. nor Croft remedy the deficiencies of Rink et al. Therefore, since claim 2 is directly dependent on claim 1, the subject matter of claim 2 is patentable over Rink et al. for the same reasons that the subject matter of claim 1 is patentable over this reference.

For these reasons, the invention of claim 2 is clearly patentable over Rink et al. in view of Asahina et al. and Croft.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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